

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

As a preliminary matter, Applicant notes the Office Action's approval of the drawings filed on July 30, 2004 and consideration of the Information Disclosure Statement filed on March 17, 2004.

The specification and title stand objected to for minor informalities. Claims 1, 2 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0104003 to Iwamura. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura in view of U.S. Patent No. 6,823,455 to Macy et al. Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura and in view of U.S. Patent Application Publication No. 2001/0028726 to Miyake. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura and Miyake in further view of U.S. Patent No. 6,390,598 to Sato et al. (hereinafter "Sato"). Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura and Miyake in further view of U.S. Patent No. 6,912,674 to Trelewicz et al. (hereinafter "Trelewicz").

By this amendment, the title has been amended to be more clearly indicative of the invention to which the claims are directed. The specification has been amended to correct the minor informalities noted by the Examiner on page 2 of the outstanding Office Action. Applicant respectfully submits that the title and the specification are in proper form and respectfully requests withdrawal of the objections.

Claims 1-4 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Therefore, any outstanding rejections with respect to these claims have been rendered moot. Claim 5 has been amended to further define the subject matter Applicant regards as the invention as discussed in greater detail below. New claims 10-15 have been added and claims 6-9 remain unchanged in the application.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s)

remain under examination in the application, is presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 5-15 are now pending in this application for consideration.

Applicant respectfully submits that each of the pending claims is patentably distinguishable over the cited references as required by § 103. Applicant further submits that none of the cited references, whether considered alone or in combination, teaches or suggests Applicant's claimed image processing method wherein *the characteristics of the output means and the input means being specified based on model names of the output means and the input means* as recited in amended independent claim 5. New independent claim 10 includes the same patentable feature. By contrast, the cited references fail to teach or suggest this claimed feature. Accordingly, independent claims 5 and 10 and claims dependent therefrom are patentably distinguishable over the cited references. This distinction will be further described below.

THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES

In the Office Action, the claims stand rejected as being unpatentable over various combinations of Iwamura, Miyake, Sato and/or Trelewicz. In particular, independent claim 5 stands rejected as being unpatentable over the combination of Iwamura and Miyake. Applicant respectfully traverses this rejection and submits that the claims are allowable for at least the following reasons.

Applicant relies on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.¹

¹ In view of the United States Patent and Trademark Office guidelines promulgated since the U.S. Supreme Court handed down its ruling in *KSR International Co. v. Teleflex Inc.*, No. 04-1350, on April 30, 2007, these three requirements are still applicable to a rejection in view of 35 U.S.C. §103(a).

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Embodiments of the present invention are directed to an image processing method for adding information to image data. The image forming apparatus includes the step of altering a process for adding the information in accordance with characteristics of at least one of an output means of the image data and an input means of the image data.

According to one embodiment of the present invention as recited in amended independent claim 5, *the characteristics of the output means and the input means is specified based on model names of the output means and the input means*. An exemplary embodiment of the present invention is described as the fourth embodiment of the invention, whereby an optimal process is executed by recognizing in advance the characteristics of the input/output device that is used by having the model names of typical devices, which are widely marketed and whose characteristics are known explicitly indicated in advance on the input/output device select means 401 (illustrated in FIG. 7) (*see*, Specification, page 11, line 24 through page 12, line 5). The model names are then grouped and displayed to the user, whereby one of the groups is selected and the digital watermark embedding process is switched according to the results of the selection (page 12, lines 5-8). With this arrangement, the present method allows a user, unfamiliar with a particular device, to still execute an optimal digital watermark embedding process with less possibility of erroneous reading (page 12, lines 9-14). Applicant respectfully submits that none of the cited references teaches or suggests the claimed feature or provides the corresponding benefit discussed above.

The primary reference of Iwamura is directed to a digital watermark processing apparatus for adding information to image data. The Office Action correctly notes at page 6,

that Iwamura fails to disclose the step of “altering a process for . . . at least one of the output means of the image data **and** the input means of the image data” as required by independent claim 5. The Office Action then relies on the Miyake reference to cure this deficiency. Applicant would like to point out the Iwamura reference also fails to disclose or suggest that ***the characteristics of the output means and the input means is specified based on model names of the output means and the input means*** as now required by amended independent claim 5.

Miyake is directed to an image processing apparatus and method for extracting embedded information from an image. Miyake’s method appears to incorporate the steps of entering an image with predetermined embedded information, filtering the image, detecting plural feature amounts and extracting the predetermined information based on the detected plural feature amounts (Abstract, lines 6-11). Applicant respectfully submits, however, that Miyake also fails to disclose or suggest that ***the characteristics of the output means and the input means is specified based on model names of the output means and the input means*** as now required by amended independent claim 5. At best, Miyake discloses a scanner 104 used as the input means and a printer 103 used as the output means, but fails to disclose or even remotely suggest the model name of these devices being displayed for the user’s selection when the user is unfamiliar with these devices.

Applicant respectfully submits that the Sato and Trelewicz references fail to cure the deficiencies of the combination of Iwamura and Miyake and were not cited for that purpose. Thus, independent claim 5 is allowable. Since independent claim 5 is allowable, claims dependent therefrom, namely claims 6-9 are allowable by virtue of their direct or indirect dependence from allowable claim 5 and for containing other patentable features.

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied in the Office Action, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

Lack of Suggestion or Motivation to Modify or Combine the References

The Supreme Court recently addressed the appropriate standard for obviousness in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (U.S., April 30, 2007). The Court explained that the proper question for evaluating obviousness is “whether there was an apparent reason to combine the known elements in the fashion claimed.” *KSR*, slip op. at 14. Here, the record evidences no such reason.

Iwamura is devoid of any reason why one of skill in the art would incorporate the teachings of Miyake into Iwamura. The Office Action at pages 7 and 8, states that it would have been obvious to combine Miyake and Iwamura “to precisely read the dot information of the print . . .,” citing Miyake at paragraph 89, lines 4 and 5. Thus, the proffered motivation, even assuming that the underlying results do in fact occur from general implementation of the teachings of Miyake, does not mean that the ordinary artisan would have incorporated the step of altering a process for at least one of the output means **and** the input means of the image data of Miyake into the method of Iwamura. Instead, the Office Action all but relies on Applicant’s disclosure for motivation to modify the primary reference of Iwamura to arrive at the claimed invention, the Office Action citing nothing in the prior art that provides the specific motivation to modify the references to arrive at the invention as claimed.

The Supreme Court also emphasized the significance of unexpected results to an obviousness analysis. The Court explained that “[t]he combination of familiar elements . . . is likely to be obvious when it does no more than yield predictable results.” *KSR*, slip op. at 12. Here, however, there is no evidence that the results achieved by combining the step of altering a process for at least one of the output means **and** the input means of the image data, *e.g.*, to effectively reduce the possibility of degradation of the digital watermark, was “predictable.” Indeed, because no cited reference suggests any advantage to providing the altering step as discussed above, the record only supports a finding that the results achieved by the present invention are unexpected and, therefore, that the claimed subject matter is not obvious.

In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

Applicant respectfully submits that independent claim 5 and claims dependent therefrom are patentably distinguishable over the cited references and thus, allowable. Further remarks regarding the asserted relationship between any of the claims and the cited references are not necessary in view of their allowability. Applicant's silence as to the Office Action's comments is not indicative of being in acquiescence to the stated grounds of rejection.

NEW CLAIMS

New independent claim 10 has been added to the application. New independent claim 10 is an apparatus claim directed to a device that practices the method of claim 5 and includes the same patentable feature discussed above. Thus, for substantially the same reasons advanced above with respect to independent claim 5, claim 10 is also allowable. New dependent claims 11-15 are allowable by virtue of their direct or indirect dependence from allowable independent claim 10 and for containing other patentable features.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

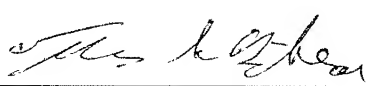

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for

such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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